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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,973

11/13/2003

Hemant M. Chaskar

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EXAMINER

HUYNH, CHUCK

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/705,973

Applicant(s)

CHASKAR ET AL.

Examiner

Chuck Huynh

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 2-7, 9-14, 16-24, 26-31, 33-38, 40-42 and 44-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 15, 25, 32, 39, 43 and 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

***Election/Restrictions***

1. Applicant's election of Group 1 in the reply filed on 6/7/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

1. Claims 2-7, 9-14, 16-24, 26-31, 33-38, and 40-42, 44-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups, there being no allowable generic or linking claim.

2. Applicant's election of claims 1, 8, 15, 25, 32, 39, 43, 49-51 in the reply filed on 6/7/2006 is acknowledged.

***Information Disclosure Statement***

3. The information disclosure statements received on 2/11/2005 and 11/13/2003 are has been considered by Examiner.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**1. Claims 1, 8, 15, 49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Honkala et al. (WO 00/67514 (provided in IDS); hereinafter Honkala).**

Regarding claim 1, Honkala discloses a method of controlling handover between a first technology network (WIO system / internal cellular communication network) and a second technology network (GSM system / external cellular communication network), comprising the steps of:

detecting information about regions of an area of the first technology network (Figs. 1, 3-5; Abstract; Page 6, 14-26; Page 8-10); and

deciding initiating a handover procedure between the first and second technology networks based on the detected region information (Figs. 1, 3-5; Abstract; Page 6, 14-26; Page 8-10).

Regarding claim 8, Honkala discloses a method of controlling handover between a first technology network and a second technology network, comprising the steps of:

detecting information about regions of an area of the first technology network (Figs. 1, 3-5; Abstract; Page 6, 14-26; Page 8-10); and

deciding preparing a handover procedure between the first and second technology networks based on the detected region information (Figs. 1, 3-5; Abstract; Page 6, 14-26; Page 8-10).

Regarding claim 15, Honkala discloses a method of controlling handover between a first technology network and a second technology network, comprising the steps of:

detecting information about regions of an area of the first technology network (Figs. 1, 3-5; Abstract; Page 6, 14-26; Page 8-10); and

deciding preparing a handover procedure between the first and second technology networks based on the detected region information, and deciding performing actual handover between the first and second technology networks based on the detected region information (Figs. 1, 3-5; Abstract; Page 6, 14-26; Page 8-10).

Regarding claim 49, Honkala discloses an access node of a first technology network, comprising:

means for setting information about at least a first region and a second region of an area of the first technology network in which region the access node is located (WIO cell to another WIO cell or WIO zone to another WIO zone: Figs. 1, 3-5; Abstract; Page 6, 14-20; Page 8-10); and  
means for transmitting the region information (BTS, Figs. 1, 3-5; Abstract; Page 6, 14-16; Page 8-10).

Regarding claim 51, Honkala discloses a communication network system, comprising:  
a mobile node (mobile station BS) according to claim 49 (Abstract).

**2. Claims 25, 32, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Hjern et al. (WO 96/25015 (provided in IDS); hereinafter Hjern).**

Regarding claim 25, Hjern discloses a mobile node for controlling handover between a first technology network (DECT) and a second technology (GSM) network (Abstract), comprising:

means for detecting information about regions of an area of the first technology network (Abstract); and

means for deciding initiating a handover procedure between the first and second technology networks based on the detected region information (Abstract; Page 7, lines 14-38).

Regarding claim 32, Hjern discloses a mobile node for controlling handover between a first technology network and a second technology network, comprising:

means for detecting information about regions of an area of the first technology network (Abstract; Page 7, lines 14-38); and

means for deciding preparing a handover procedure between the first and second technology networks based on the detected region information (Abstract; Page 7, lines 14-38).

Regarding claim 39, Hjern discloses a mobile node for controlling handover between a first technology network and a second technology network, comprising:

means for detecting information about regions of an area of the first technology network (Abstract; Page 7, lines 14-38); and

means for deciding preparing a handover procedure between the first and second technology networks based on the detected region information, and means for deciding performing actual handover between the first and second technology networks based on the detected region information (Abstract; Page 7, lines 14-38; Page 11, line 11 – Page 12, line 23).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honkala in view of Hjern.**

Regarding claim 43, Honkala discloses a mobile node for controlling handover between a first technology network and a second technology network, comprising:

means for detecting information about a movement of a mobile node in the first technology network (Figs. 1, 3-5; Abstract; Page 6, 14-26; Page 8-10); and

means for deciding initiating a handover procedure between the first and second technology networks based on the detected region information and movement information (Figs. 1, 3-5; Abstract; Page 6, 14-26; Page 8-10).

Honkala discloses detecting the movement of said mobile station into said border cell (Abstract) and all the particulars of the claim but might be unclear about

means for detecting information about regions of an area of the first technology network.



However Hjern does disclose means for detecting information about regions of an area of the first technology network (Abstract; Page 7, lines 14-38).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate Hjern's disclosure to detect a mobile's location to improve handover depending on stronger service location.

**5. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honkala in view of Chiou et al. (US 6473413; hereinafter Chiou).**

Regarding claim 50, Honkala discloses the access node according to claim 49, in which the access node is a WLAN access point (Wireless Intranet Office: page 1, line 23) and even though Honkala discloses handing off between cells/zones with corresponding base station transceiver in each cell/zone Honkala is unclear on that the setting means is **capable of** setting region information by assigning proper values to certain bits reserved in the beacon frames of the WLAN access points, the bit values indicating the region information where the access point is located (Access Point address).

Chiou does disclose the setting means is capable of setting region information by assigning proper values to certain bits reserved in the beacon frames of the WLAN access points, the bit values indicating the region information where the access point is located (Abstract; Col 1, lines 14-39; Col 3, lines 18-45).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate base station addresses to improve establishment of handover from base station to another identified base station.

In addition, it has been held that the recitation that an element is “**capable of**” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138. Therefore, it’s an obvious expedient.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Huynh whose telephone number is 571-272-7866. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Chuck Huynh

 6/22/06  
ELISEO RAMOS-FELICIANO  
PRIMARY EXAMINER